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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,402	12/31/2003	Paul T. Van Gompel	19,577	8997
23556	7590	02/22/2005	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			CHAPMAN, GINGER T	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/750,402	VAN GOMPEL ET AL.
	Examiner	Art Unit
	Ginger T Chapman	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 January 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-51 is/are pending in the application.

4a) Of the above claim(s) 1-33 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 34-51 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Election/Restrictions

Newly amended claims 1-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-33, drawn to nonabsorbent underwear having an opening in the crotch, classified in class 2, subclass 408.
- II. Claims 34-45 and 47-51, Figures 1 and 9, drawn to absorbent means interposed between a topsheet and backsheet, classified in class 604, subclass 385.23.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 46 has been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-35, 38, 40-43, 45, 47-48, 50 and 51 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,037,416 issued to Allen et al.

As depicted in Figures 5 and 7, Allen et al disclose an absorbent garment which includes a liquid impermeable outer layer which may be pleated (col. 4, line 48); an absorbent core made from materials commonly used in the art (col. 3, lines 59-60 and 62-64) which may be joined to the outer layer (col. 3, line 65); a liquid permeable inner layer (12) which is elastic in the lateral (col. 7, lines 5-6) and longitudinal (col. 4, lines 19-24) directions and further having a perimeter (22, 24, 50: col. 2, lines 66-68). The elastic inner layer may be constructed of two or more layers of material (col. 6, lines 27-28) and have zones of differing elastic properties (col. 13, line 41). The outer layer length is greater than the inner layer length in the longitudinal direction (col. 13, lines 14-15) and the inner and outer layers may be at least partially joined at their perimeters using ultrasonic, heat/pressure or adhesive in a variety of bonding patterns (col. 4, lines 51-52).

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,269,775 issued to Freeland et al.

Freeland et al teach a disposable absorbent garment having an outer layer (24), an elastic inner layer (col. 2, line 68 to col. 3, lines 1-4) defining an internal opening (col. 7, lines 4-5 and line 13) and an absorbent assembly positioned between the bonded (col. 4, lines 5-9) outer and inner layer, said assembly further including a topsheet layer (col. 5, lines 67-68, see also lines 55-56), core layer (col. 5, lines 47-49) and barrier layer (col. 6, line 34-35 and lines 45-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen as applied to claim 1 above, and further in view of U.S. Patent No. 5,269,775 issued to Freeland et al.

With regard to claim 49: Allen discloses an absorbent garment wherein the outer layer length is greater than the inner layer length in the longitudinal direction (col. 13, lines 14-15) thereby creating a void space for isolating waste material between the layers. Allen fails to teach an outer layer lateral width that is greater than the lateral width of the inner layer. Freeland et al teach an elastic inner layer for an absorbent garment wherein the garment outer layer has a greater width in both the lateral (col. 5, lines 2-4) and longitudinal (col. 4, lines 62-63) directions thereby providing a snug inner layer fit while the garment is worn. It would therefore be obvious having ordinary skill in the art at the time the invention was made to construct the garment of Allen with an outer layer having a greater width in the lateral direction as taught by Freeland to provide a more comfortable fit to the wearer while the garment is in use.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen as applied to claim 1 above, and further in view of U.S. Patent No. 4,756,709 issued to Stevens.

Allen et al disclose an absorbent garment having an elastic inner layer but fail to address a stretchable outer layer. As best depicted in Figures 14 and 19, Stevens teaches an absorbent garment having an absorbent assembly (col. 7, lines 10-12) and an outer cover wherein the outer cover (20) is resiliently stretchable in the longitudinal and lateral directions (71, 73,) and laterally extensible (80, 82) thereby enhancing the ability of the garment to conform to the anatomy of the wearer while the wearer engages in various activities and positions. Therefore, to have

constructed the diaper of Allen with a stretchable outer layer as taught by Stevens to produce a diaper providing an improved fit to the wearer of the garment, since Stevens states at column 3, lines 49-52 that such a stretchable outer layer provides a form fitting diaper that conforms to a baby's shape would have been obvious to one having ordinary skill in the art at the time the invention was made.

Claims 39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen as applied to claim 1 above, and further in view of U.S. Patent No. 5,817,086 issued to Kling.

Allen et al disclose the use of inner and outer layers having two or more layers or laminae of materials. Allen teaches a vapor permeable outer layer (col. 4, line 18) but fails to teach the use of liquid impermeable inner layers or liquid permeable outer layers in an absorbent garment such as a diaper. However, it is well known in the diaper art that "layer" when used in the singular can have the dual meaning of a single element or a plurality of elements.

Kling discloses the use of layers having a plurality of elements. In particular, Kling teaches an absorbent garment having an outer layer (Figure 1: (5)), an inner layer (2) and an absorbent assembly (4) which may be joined to the outer layer with the inner and outer layers joined at their perimeters (6, 7, 8, 9). The outer layer consists of a laminate of materials such as, for example, polyethylene or polypropylene with a liquid permeable fiber fabric. The bottom layer can also comprise a laminate having a thermoplastic layer and a fiber fabric, or a fiber fabric extrusion coated with a plastic film wherein the liquid permeable fiber fabric is placed outermost so that the diaper is given a textile look (col. 3, lines 60-68) thereby providing a pleasing cloth-like appearance and feel to the user.

Therefore, to have constructed the outer layer of the diaper of Allen with the liquid permeable fiber fabric placed outermost as taught by Kling to provide a pleasing cloth-like feel and appearance for the user of the garment would have been obvious to one of ordinary skill in the art at the time the invention was made.

As best depicted in Figures 3 and 4, Kling further teaches a liquid impermeable inner layer (2) having an opening (17) permitting the passage of liquid through the inner layer (col. 8, lines 44-51) to the absorbent assembly while maintaining a dry feel to the surface of the inner layer in contact with the skin of the wearer thus reducing skin irritation or "diaper rash." It would be obvious to one of ordinary skill in the art at the time the invention was made to construct the inner layer of Allen with a liquid impermeable material as taught by Kling to provide a dry skin-contacting surface to the wearer to reduce skin irritation.

Response to Arguments

Applicant's arguments filed on 26 January 2005 have been fully considered but they are not persuasive.

Applicant submits that Allen does not describe a disposable garment that does not include an absorbent assembly. As detailed above, Applicant's arguments with respect to claims 1-33, drawn to nonabsorbent underwear, are moot as they are directed to a non-elected invention classified in class 2, subclass 408.

Applicant further submits that an object of Steven's stretchable outer cover is to provide a form fitting shape while one of the objects of Allen is to create a void space. However, Applicant acknowledges that Allen states at col. 13, line 3 that the topsheet conforms to the

wearer, and Stevens states at col. 3 the diaper conforms to the baby's shape. Allen further states at col. 13, lines 31-33 that the diaper "provides close and snug conformance of the topsheet to the wearer," Examiner maintains that the motivation to produce a diaper providing a conforming fit is present in Allen and Stevens, alone and in combination, thereby establishing a *prima facie* case of obviousness.

Applicant submits Allen does not teach the elastic inner layer perimeter bonded to the outer layer perimeter and suggests Examiner is referring to elastic members (19) joined to the backsheet. Examiner does not rely on the elastic members (19) for the inner and outer layer perimeter bonding; the elastic members render the crotch piece extensible in a lateral direction. The perimeter bonding is described in col. 2, lines 61-68: "the topsheet and backsheet are at least peripherally joined... the periphery comprises a first end (22), a second end (24) and longitudinal marginal portions (50).", see also col. 3, lines 35-48: "the topsheet and backsheet of the diaper are at least peripherally joined... the term 'join' refers to the condition where a first member or component is affixed or connected to a second member or component..." Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. It is noted that the end product claimed is a garment, not a method of bonding, i.e. if an absorbent garment of the prior art is the same as the end product in the claims, the claims are unpatentable even though it was made by a different process (See MPEP § 2113).

Applicant submits that neither Allen nor Steven have an outer layer elastic inner layer having a retraction value that is less than the inner layer retraction value. When viewing the claimed invention the limitations drawn to test results, i.e., retraction values, are being considered as product-by-process limitations. Accordingly § 2113 of the MPEP, some of which is reproduced below, dictates the manner in which the claims have been examined. Since the product can only be understood by finding the result of certain claimed characteristics, which are the result of tests, the burden of proof to overcome any rejection must be shifted to the applicant.

"The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter,

the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T Chapman whose telephone number is (571) 272-4934. The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ginger Chapman
Examiner, Art Unit 3761



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700